

REMARKS

I. Introduction

In response to the Office Action dated November 29, 2005, claims 1-7, 23-29 and 45-51 have been amended. Claims 1-66 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicant's attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art.

III. Prior Art Rejections

A. The Office Action Rejections

On page (5) of the Office Action, claims 1-16, 19-38, 41-60, and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over "Special Edition Using Microsoft Outlook 2002" (Padwick-Outlook 2002) in view of U.S. Publication No. 2004/0080528 (Rand). On page (21) of the Office Action, claims 1-16, 19-38, 41-60, and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over "Special Edition Using Microsoft Outlook 2000" (Padwick-Outlook 2000) in view of U.S. Patent No. 6,009,442 (Chen).

Applicant's attorney respectfully traverses these rejections, in view of the amended claims above and the arguments below.

B. The Rejections Based on Padwick-Outlook 2002 and Rand

With regard to the rejections based on Padwick-Outlook 2002 and Rand, Applicant's attorney submits herewith a revised Declaration under 37 C.F.R. §1.131 by inventor Lee Anne Kowalski and a new Declaration under 37 C.F.R. §1.131 by Applicants attorney George H. Gates to eliminate Padwick-Outlook 200 and Rand as references.

The Office Action, beginning on page 2, objects to the previously-submitted Declaration under 37 C.F.R. §1.131, and asserts that it is insufficient to overcome the rejections due to the following: (1) the statement that the invention was reduced to practice "in this country" is insufficient to establish that the invention was reduced to practice in the U.S.A.; and (2) the

Declaration does not adequately recite facts to support the dates of conception and reduction to practice.

Applicant's attorney disagrees with these assertions, but nonetheless submits herewith a revised Declaration under 37 C.F.R. §1.131 by inventor Lec Anne Kowalski and a new Declaration under 37 C.F.R. §1.131 by Applicants attorney George H. Gates to eliminate Padwick-Outlook 200 and Rand as references, in the interest of expediting prosecution. The revised Declaration and new Declaration address the objections set forth in the Office Action:

C. The Rejections Based on Padwick-Outlook 2000 and Chen

The Office Action also asserts that the combination of Padwick-Outlook 2000 and Chen renders obvious all the elements of the Applicant's claims.

The Office Action cites the Padwick-Outlook 2000 reference for creating rules to filter emails based on whether the user-specified terms are in the email. However, as admitted by the Office Action, the Padwick-Outlook 2000 reference does not make alternations to the emails to identify the matched terms and to indicate their significance to the reader. Nonetheless, the Office Action asserts that Chen teaches these limitations in that its document management system allows a user to define criteria comprising key terms, wherein the system identifies documents that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms.

Applicant's attorney submits that the independent claims distinguish over the references.

Specifically, neither of the references teach or suggest making alterations within the electronic message itself to identify the matched message terms and to indicate their significance.

Instead, the combination of references merely searches emails or other text for a particular term or phrase, and then highlights the display of that particular term or phrase when found, but without altering the message, email or text itself.

Thus, even when combined, the references teach away from Applicant's invention. Moreover, the various elements of Applicant's claimed invention together provide operational advantages over the references. In addition, Applicant's invention solves problems not recognized by the references.

As a result, Applicant's attorney submits that independent claims 1, 23, and 45 are allowable over Padwick-Outlook 2000 and Chen. Further, dependent claims 2-22, 24-44, and 46-66 are submitted to be allowable over Padwick-Outlook 2000 and Chen in the same manner, because they are dependent on independent claims 1, 23, and 45, respectively, and thus contain all the limitations

of the independent claims. In addition, dependent claims 2-22, 24-44, and 46-66 recite additional novel elements not shown by Padwick-Outlook 2000 and Chen.

IV. Conclusion


In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephonic interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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Date: February 27, 2006

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G&C 30571.266-US-01